

REMARKS

Applicants initially wish to extend appreciation to Examiner Chu that the rejections of the claims made in the Office communication mailed on February 4, 2009 apparently have been withdrawn as they were not repeated in the current Office communication and the rejections of the current Office communication are not based upon prior art previously cited and considered in the present application. Furthermore, applicants wish to extend appreciation that Examiner Chu recognizes that Franco is deficient from the claims of the present application. It is respectfully submitted that the present rejection utilizes the hindsight knowledge of the present invention in selecting elements which are contended to meet the recitations of the claims and then arranging those selected elements in just the right way to meet the recitations of the claims.

Although Markovics shows foldable sheets 26 each formed by panels 28, 30, 32 and 34 along diagonal fold lines 41 and "joined together in strip fashion", Markovics discloses the rear surfaces of panels of adjacent sheets are affixed so closing one sheet 26 will open the next sheet 46 and specifically does not disclose that such foldable sheets 26 are attached in series by frangible zones of material to form an elongate web. In fact, it would be against the teachings of Markovics to attach foldable sheets 26 as an elongate web and would destroy the operation of album as set forth at column 4, line 53 and following of Markovics to do so. Thus, it should be appreciated that Markovics provides no teaching or suggestion as to how to fold a web of material comprising a multiplicity of individual portions integrally connected together in series by frangible zones in a manner as recited in the claims of the present application. In particular, the only teaching of Markovics that is being relied upon is radially extending fold lines and all of the other teachings of Markovics must be ignored and disregarded. It is then respectfully submitted that the present rejection is a piecemeal reconstruction of the prior art utilizing the hindsight knowledge of the present invention for several reasons. Initially, it is respectfully submitted that Markovics is non-analogous art. In this regard, form paragraph 7.37.05

Unpersuasive Argument: Nonanalogous Art of the MPEP indicates:

In response to applicant's argument that [1] is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, [2].

The facts of the Oetiker case are:

Oetiker's invention is an improvement in a "stepless, earless" metal clamp, a hose clamp that was generally described in an earlier '004 patent of Oetiker, but that differs in the presence of a feature that is described as a preassembly "hook". This "hook" serves both to maintain the preassembly condition of the clamp and to be disengaged automatically when the clamp is tightened.

The cited references were Oetiker's earlier-granted '004 patent, combined with a certain Lauro '004 patent. Lauro describes a plastic hook and eye fastener for use in garments, in which "unitary tabs of sewing needle puncturable plastic material ... are affixable to clothing and the like by sewing".

* * *

The examiner stated that "since garments commonly use hooks for securement", a person faced with the problem of unreliable maintenance of the pre-assembly configuration of an assembly line metal hose clamp would look to the garment industry art. The examiner explained further by stating that "Appellant's device as disclosed could be utilized as part of a garment". The Board did not repeat or support the examiner's argument, or discuss its relevance. Indeed, the argument is not supportable. However, the Board held that the Lauro reference, although not "within the appellant's specific field of endeavor" is nonetheless "analogous art" because it relates to a hooking problem, as does Oetiker's invention.

The Board apparently reasoned that all hooking problems are analogous...

The Court of Appeals for the Federal Circuit reversed the Board of Appeals in Oetiker stating:

... We have reminded ourselves and the PTO that it is necessary to consider "the reality of the circumstances", *In re Wood*, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979)--in other words, common sense--in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor.

It has not been shown that a person of ordinary skill, seeking to solve a problem of fastening a hose clamp, would reasonably be expected or motivated to look to fasteners for garments. The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a prima facie case of obviousness. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge can not come from the applicant's invention itself. *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 678-79, 7 USPQ2d 1315, 1318 (Fed. Cir. 1988); *In re Geiger*, 815 F.2d 686, 687, 2 USPQ2d 1276, 1278

(Fed.Cir.1987); *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1147,227 USPQ 543, 551 (Fed.Cir.1985).

It is respectfully submitted that a person working in the field of storage and packaging of convenience devices would not be expected or motivated to look to albums or to foldable sheets having their rear surfaces connected together and not as a web in series. It is improper to reason that all "folding" problems are analogous. Additionally, claim 33 has been incorporated into claim 9 to further define the field of the convenience device of the present invention to make it unrealistic for a person skilled in the art to be expected to look for a solution faced by the present invention in Markovics. Thus, it is respectfully submitted that the rejections of the claims have been overcome. Favorable reconsideration is respectfully requested.

Furthermore and even assuming that Markovics is analogous art, as set forth in the Oetiker case, there must be some reason, suggestion or motivation found in the prior art whereby a person of ordinary skill would make the combination. In this regard, Franco provides no teaching or suggestion that it is deficient, that further improvement is possible, and/or that the tissues 10 could be folded in other manners. Likewise, Markovics only teaches radially extending fold lines, with all of its other teachings being contrary to the teachings of Franco (and the recitations of the claims of the present application.) Additionally, it is respectfully submitted that the Examiner cannot pick and choose elements from Markovics to the exclusion of the other elements taught therein. As stated by the CCPA in In re Kamm and Young, 172 USPQ298 at 301 and 302:

The rejection here runs afoul of a basis mandate inherent in Section 103--that "a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure" shall not be the basis for a holding of obviousness. In re Rothermel, 47 CCPA 866, 870, 26 F.2d 393, 396, 125 USPQ 328, 331 (1960). "It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." In re Wesslau, 53 CCPA 746, 750, 353 F.2d 238, 241, 147 USPQ 391, 393 (1965). We think this has been done here.

We appreciate the relative ease with which one can slip into such an error, especially where, as here, the primary reference addresses the same problem as appellants and solves it using merely a different chemical agent. However, we are satisfied that when the secondary references are viewed in their entirety, with due consideration given to what they fail to disclose and what

they disclose as undesirable, it is evident that the proposed modification of the primary reference would not have been obvious to one of ordinary skill in the art at the time the invention was made.

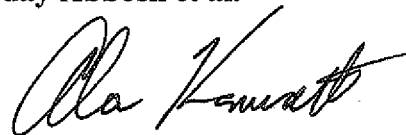
Applicants then believe that the Examiner has slipped into the improper picking and choosing of components of the references in a similar manner as in the Kamm decision. Therefore, it is submitted that the present rejections under Section 103 are improper for these separate and independent reason. Favorable reconsideration is respectfully requested.

Likewise, as Markovics does not teach or disclose a web having a longitudinal axis, how can Markovics teach or disclose the arrangement of fold lines relative to the longitudinal axis as recited in claims 23-25 and 29-32 of the present application. Thus, it is respectfully submitted that the rejections of claims 23-25 and 29-32 have been overcome for this separate and independent reason. Favorable reconsideration is respectfully requested.

Therefore, since the claims of the present application have been shown to include limitations directed to the features of applicants' Convenience Rolls, which are neither shown, described, taught, nor alluded to in any of the references cited by the Examiner and by the applicants, whether those references are taken singly or in any combination, the Examiner is requested to allow claims 3, 5, 8-10, 12-14, 23-25, 29-32 and 34-37, as amended, of the present application and to pass this application to issue.

In view of the foregoing remarks, it is believed that the application is now in condition for allowance and such action is respectfully requested. If any points remain in issue which the Examiner feels could best be resolved by either a personal or telephone interview, the Examiner is urged to contact Applicants' attorney at the exchange listed below.

**Respectfully Submitted,
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